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REMARKS

The Examiner has rejected Claims 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 112, second paragraph, as being indefinite.

First, the Examiner has stated that applicant's claimed "storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier" is unclear. Applicant respectfully asserts that such language is clear in that what is claimed is the storing of a manually selected file in a manner such that the file is associated with at least one identifier.

Second, the Examiner has stated that the word "accessible" in applicant's claimed technique "wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier," is unclear. In response, applicant points out the plain and ordinary meaning of the term "accessible," which is evidenced by the exemplary definition set forth hereinbelow:

ac-ces-si-ble      adj. "Easily obtained"

*The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company.  
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Thus, clearly applicant claims that the manually entered notes, at least one of the manually selected files, and the patents are capable of being easily obtained by way of a subsequent selection of the at least one identifier.

Third, the Examiner has stated that it is unclear what the word "reported" means in applicant's claimed technique "wherein a set of patents is reported." However, applicant specifically claims how such patents are reported in the following claim language:

“displaying a technology mapping depicting at least one category of  
technology utilizing a graphical user interface,  
displaying statistics regarding a number of the patents of the set in each  
category of technology,

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displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology,

displaying second additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure,

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface.”

Fourth, the Examiner states that it is unclear what “made accessible” means in the context of applicant’s claimed technique “wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail.” In response, applicant again points out the plain and ordinary meaning of the term “accessible,” which is evidenced by the exemplary definition set forth hereinabove. Thus, clearly applicant claims that the notes and at least one of the files are capable of being easily obtained by other parties utilizing email.

Fifth, the Examiner has questioned what applicant means by “associating a plurality of patents with the at least one identifier.” Applicant respectfully asserts that such claim language is clear, in that what is claimed is a plurality of patents that are associated with, or in other words corresponding to, at least one identifier.

The Examiner has rejected Claims 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 101 as being directed toward non-statutory subject matter. Such rejection is deemed overcome by virtue of the amendments above.

The Examiner has rejected Claims 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (U.S. Patent Application Publication No. 2003/0046307).

The Examiner has again restated the argument that Applicant’s arguments fail to comply with 37 CFR 1.111 (b) because they amount to a general allegation that the claims define a

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patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant respectfully disagrees. Specifically, reiterated below are arguments (that were previously submitted, at least part), which clearly point out how the language of the claims patentably distinguishes them from the references, in specific terms of the claim language for which the Examiner has still not been able to make a specific prior art showing.

Applicant again further argues that many benefits arise from the synergy of the technology mapping, and the remaining claimed framework. Specifically, a user is capable of associating patents with at least one identifier (with additional notes associated therewith), and also obtaining technology-related metrics regarding a set of patents, with one framework that is more effectively organized. Specifically, only applicant teaches and claims such a drill-down technique for accessing information relating to the patents subject to the technology mapping, which is believed to be unique, when taken in combination with the remaining claim elements.

In addition, the Examiner has again admitted in the latest Office Action dated 10/11/2005 that Rivette fails to explicitly disclose a technology mapping depicting at least one category of technology or wherein the first additional information includes a list of the patents of the set associated with one category of technology, or wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure, or wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface, or wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail; as claimed by applicant.

The Examiner goes onto simply dismiss such novel limitations as being nonfunctional descriptive material and not functionally involved in the acts or structure recited. The Examiner also argues that the data does not alter how the system functions or the acts are performed.

Applicant vehemently disagrees with the Examiner on this point. By requiring the very specifically claimed manner (i.e. separate interfaces, etc.) in which the acts are performed

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(i.e. separate icons, etc.), a significantly improved manner of organizing, displaying, and accessing patent-related information is achieved.

In addition, such language is functional in that it claims the specific manner in which a “set of patents is reported,” as found in each of the independent claims. Thus, the set of patents is specifically reported by:

“displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface,”

“displaying statistics regarding a number of the patents of the set in each category of technology,”

“displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon, wherein the first additional information includes a list of the patents of the set associated with one category of technology,”

“displaying second additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure,”

“wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface” (see this or similar, but not identical, language in each of the independent claims, as amended).

Still yet, with respect the above independent claims, the foregoing arguments of the Examiner are further deemed ineffective, as each of the claims of the present group are computer program product or computer readable medium claims.

It appears that the excerpts from Rivette relied upon by the Examiner are deficient in numerous respects. For example, the Examiner relies on the following excerpts from Rivette to make a prior art showing of applicant's claimed “displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface, displaying

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statistics regarding a number of the patents of the set in each category of technology" (see this or similar, but not identical, language in each of the independent claims, as amended).

"[0025] The processing automatically performed by the invention relates to (but is not limited to) patent mapping, document mapping, document/patent citation both forward and backward), document/patent aging, patent bracketing/clustering (both forward and backward), inventor patent count, inventor employment information, and finance. Other functions also fall within the scope of the invention.

[0262] For example, a patent's value may be linked to whether it covers technology that the corporation is currently using, or that the corporation may use in the future. For this and other purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with manufacturing information 208 and/or R & D information 206. Also, a patent's value may be linked to whether it has generated licensing revenue. For this and other purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with the licensing information 214. Further, a patent's value may be linked to the degree of success of the corporation's commercial products related to the patent (i.e., the commercial embodiments of the patented technology). For this and other purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with the financial information 216.

[0277] FIG. 3 is a block diagram of a system 302 according to an embodiment of the invention. The system 302 includes a plurality of databases 316 that store patent information and other information, such as R & D (research and development) information, financial information, licensing information, manufacturing information, HR (human resources) information, and any other information that may be pertinent to the analysis of the patent information. The terms "database" and "table" are used synonymously herein."

After a careful review of such excerpt, however, it is clear that Rivette merely suggests linking value to a patent based on an associated technology. There is not even a suggestion, in such excerpt, of any sort of displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface (emphasis added), let alone displaying statistics regarding a number of the patents of the set in each category of technology (emphasis added), as claimed, in combination with the remaining claim elements.

Further, the Examiner relies on the following excerpt from Rivette to make a prior art showing of applicant's claimed technique "wherein the first additional information includes a list of the patents of the set associated with one category of technology" (see this or similar, but not identical, language in each of the independent claims, as amended).

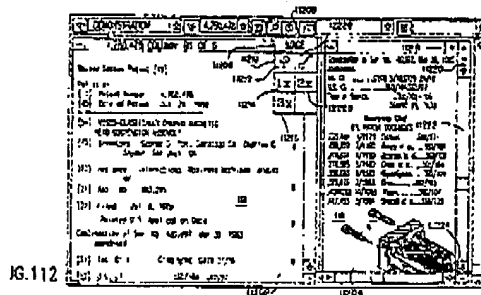
"[0331] Information on groups is stored in the group databases 621. Generally, a group is a data structure that includes any number of documents that typically follow a common theme or characteristic (although this is not a mandatory requirement of groups). More

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particularly, a group is a data structure that includes any number of patents that typically follow a common theme or characteristic (although, again, this is not a mandatory requirement of groups). Groups are document-centric, or in many cases, patent-centric."

After a careful review of such excerpt, however, it is clear that Rivette merely links value to a patent based on a technology. There is not even a suggestion, in such excerpt, of any sort of first additional information (that is displayed upon the selection of an icon, as claimed) including a list of the patents of the set associated with one category of technology (emphasis added), as claimed, in combination with the remaining claim elements.

Still yet, the Examiner relies on the following figure from Rivette to make a prior art showing of applicant's claimed technique "wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface" (see this or similar, but not identical, language in each of the independent claims, as amended).



As mentioned earlier, Rivette fails to even suggest applicant's claimed applicant's statistics and first additional information, as claimed, and thus can simply not meet the present claim language incorporating the same. There is not even a suggestion, in the cited excerpt, of any sort of statistics (as claimed) displayed in a first interface, first additional information (as claimed) is displayed in a second interface separate from the first interface, and the second additional information (as claimed) is displayed in a third interface separate from the first interface and the second interface (emphasis added), as claimed, in combination with the remaining claim elements.

Furthermore, in the latest Office Action dated 10/11/2005, the Examiner has argued that the first element of the prima facie case of obviousness has been met because the motivation

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came from the knowledge generally available to one of ordinary skill in the art. Applicant respectfully points out the arguments made hereinabove which clearly show that applicant's claim language would not have been obvious in view of the Rivette reference.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

**Applicant respectfully asserts that at least the first and third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest ALL the claim limitations, and in view of the advantages associated with such novel claim limitations.** Again, a notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. For payment of any fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. SVIPGP002B).

Respectfully submitted,

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10/661,878	09/11/2003	Kevin J. Zilka	SVIPGP002B	8771
28875	7590	04/04/2006	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



# **Notice of Non-Compliant Amendment (37 CFR 1.121)**

Application No.

10/661,878

Applicant(s)

ZILKA ET AL.

Examiner

Janice A. Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 22 November 2005 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: The response is not fully responsive.
- ☒ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):  
see below

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

## TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

- Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
- Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

**Failure to timely respond** to this notice will result in:

- Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or
- Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

U.S. Patent and Trademark Office

Part of Paper No. 060329

MAY. 4. 2006 1:52PM

ZILKA-KOTAB, PC

NO. 2826 P. 23

**Continuation Sheet (PTOL-324)**

**Application No.**

Applicant has provided a one paragraph response along with an amendment in response to the Examiner's Office Action mailed on October 11, 2005. Applicant's response fails to address the rejections set forth in the Office Action, ie, 112, 2<sup>nd</sup> paragraph, and the response does not address the prior art rejection or state why the amended claims are patentable in view of the prior art of record.

The IDS submitted on 12/12/05 is being considered by the Examiner.